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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/501,944 | 02/10/2000 | Srinivasan Venkatesan | OBC-98 | 4578 |

24963 7590 07/02/2003

ENERGY CONVERSION DEVICES, INC.
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| EXAMINER |
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MERCADO, JULIAN A

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| ART UNIT | PAPER NUMBER |
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1745

DATE MAILED: 07/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/501,944

Applicant(s)

VENKATESAN ET AL.

Examiner

Julian A. Mercado

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1,4-7,10-13,15,17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1,4,6,7,10,12,13,15 and 17 is/are rejected.
- 7) ☐ Claim(s) 5,11 and 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Remarks

This Office Action is responsive to Applicant's amendment filed April 7, 2003.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 4, 6, 7, 10, 12, 13, 15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ikoma et al. in view of Bougauchi et al.

The above rejection has been discussed in detail in the previous Office Action. As the scope of the present claims are presented unamended from those considered in the previous Office Action, the prior art rejection is maintained for the reasons and for the additional reasons to follow.

Applicant's arguments filed with the present amendment have been fully considered, however they are not persuasive.

The examiner acknowledges the scope of applicant's claim which is drawn to a nickel hydroxide active material and therefore implicitly a positive electrode active material. In consideration of applicant's arguments, it appears to the examiner that applicant has assumed *a priori* that Bougauchi employs a zinc electrode (by convention a negative electrode) and therefore, the pectin is not employed as part of the active material in a positive electrode. The examiner wishes to clarify, however, that Bougauchi merely discloses pectin as part of "the

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binder consisting of Zn oxide powder and Zn powder or a simple substance of Zn powder.”

(Abstract) Nowhere does Bougauchi recite that the pectin is limited to use within the active material of a *negative electrode*, nor does Bougauchi state that the Zn oxide or powder is in itself the active material of such an electrode. The Zn oxide or powder as clearly paraphrased herein is part of the electrode's binder and not the active material *per se*.

As evidence of Zn oxide or powder as a binder material of a *positive electrode* in combination with a positive electrode active material such as nickel hydroxide, the examiner relies on U.S. Patent 5,132,177 to Kawano et al. The patentees show a positive electrode of nickel hydroxide with the addition of zinc or a zinc compound. (col. 2 line 27-34, col. 4 line 36-65) Note that contrary to applicant's assumption, zinc (Zn) disclosed in admixture to an electrode active material composition does not in itself define a negative electrode. Thus, the prior art rejection based on Ikoma et al. in view of Bougauchi et al. is maintained for the reasons of record. Applicant's arguments thereto are not persuasive for the reasons discussed above and in view of the evidence relied upon demonstrated by Kawano et al.

Allowable Subject Matter

As discussed in the prior Office Action, claims 5, 11 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent 5,132,177 to Kawano et al. for the reasons discussed *supra*.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian A. Mercado whose telephone number is (703) 305-0511. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Ryan, can be reached on (703) 308-2383. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



JAM

June 28, 2003



Patrick Ryan
Supervisory Patent Examiner
Technology Center 1700